

REMARKS/ARGUMENTS

Claims 1 - 36 remain pending in the application. Claims 1 – 36 stand rejected. No new matter has been introduced into the application. As explained in more detail below, the Applicants submit that all claims are now in condition for allowance and respectfully request such action.

Rejection under 35 U.S.C. §102

Claims 1-2, 4-5, 7-9, 15-19, 21-22, 24-26, 32-34 and 36 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Emerson, III (2003/0043974); hereinafter “Emerson”. The Applicants traverse the rejection in view of the following Remarks.

The Office Action asserts Emerson discloses methods for obtaining and resolving caller identifying parameters in a communications system. More specifically, the Office Action alleges paragraphs 0039 and 0040 of Emerson teach a method wherein a first user selects a caller ID associated with an identity of the first user and then transmitting, upon selection, the caller ID to at least one contact from a list of contacts selected from the user’s database.

Looking to paragraphs 0039 and 0040, they set forth the transmission of profile information in a canned message to be transmitted, for example, as combined with E-card, in which the E-card “can be sent to the called system during call setup”. (Paragraph 0040; emphasis added). Indeed, transmitting profile information is performed in the context of initiating contact, such as a call, with another user. (See also paragraph 0035; stating “user profile information is sent to and exchanged with corresponding systems in the call setup process, particularly in the circumstance of a failed call setup attempt due the called party not

answering”; emphasis added); and paragraph 42 (the E-card may alternatively be “passed to the other party on demand after call setup”).

In contrast, the subject matter of the rejected claims is directed towards transmitting, upon selection, the caller identification to at least one contact from a list of contacts selected from the first user’s contact database. (See independent claims 1, 18, and 36). Unlike Emerson, there is no requirement that a call be placed between a calling party and a called party. As provided in the specification, a user can “select his or her own identifier, automatically transmit it to a set of applicable users, and store all associated files or aspects of the identifying information in the receiver’s database” without waiting for the calling party to contact him or her. (Specification; para. 6). Indeed, the specification sets forth that the user may choose a video identifier instead of a contact number. As one skilled in the art will appreciate, a video may not be transmitted and played to the called party if the video was not transferred until call setup.

Therefore, Emerson does not teach, disclose, or otherwise suggest the subject matter of the rejected claims. In view of the foregoing, the Applicants respectfully request reconsideration and withdrawal of the rejection.

Rejection under 35 U.S.C. §103

Claims 3 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Emerson, III (US 2003/0043974) in view of Awada et al. (U.S. Pat. No. 6,873,861).

In response, the Applicants submit the rejected claims are not obvious in view of the cited references as the teaching, motivation, or suggestion to make the claimed combination. As

discussed in detail above, Emerson does not disclose transmitting, upon selection, the caller identification to at least one contact from a list of contacts selected from the first user's contact database. This limitation is not met or otherwise suggested by Awada, which is directed towards transmitting business cards during a phone call. Indeed, the text cited by the Examiner states "the business card data is encoded by the cellular phone and transmitted over the cellular network to the party or parties engaged in the phone call. (Col. 4, lines 51-53; emphasis added). Therefore combining Emerson with Awada does not suggest the subject matter of the rejected claims, therefore, for at least these reasons the Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 6 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Emerson, III (US 2003/0043974) in view of Morkel (US 2002/0052921).

In response, the Applicants submit the rejected claims are not obvious in view of the cited references as the teaching, motivation, or suggestion to make the claimed combination. As discussed in detail above, Emerson does not disclose transmitting, upon selection, the caller identification to at least one contact from a list of contacts selected from the first user's contact database. This limitation is not met or otherwise suggested by Morkel. The Office Action asserts that Morkel teaches transmitting the Caller ID to the list of contacts (page 1, para. 0007, page 2, para. 0011, and page 3, para. 0035) for the purpose of securely acquiring, handling, and maintaining contact information (page 1, para. 0002 and 0006). The cited paragraphs do not read upon the rejected claims. For example, claim 6 recites:

The method of claim 1, wherein the step of transmitting, upon selection, the caller identification to a list of contacts selected from the first user's contact database further comprises:

transmitting the caller identification to the list of contacts through a background transmission process.

In contrast, the cited text of Morkel sets forth that a user can attach a message to an email directed to a recipient indicating that personal information is included in the message (para. 7, 11, and 35). Therefore combining Emerson with Morkel does not suggest the subject matter of the rejected claims, therefore, for at least these reasons the Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 10 and 27 are rejected under 35 U.S.C. §103 (a) as being unpatentable over Emerson, III (US 2003/0043974) in view of Beaton et al. (U.S. Pat. No. 6,442,263).

In response, the Applicants submit the rejected claims are not obvious in view of the cited references as the teaching, motivation, or suggestion to make the claimed combination. As discussed in detail above, Emerson does not disclose transmitting, upon selection, the caller identification to at least one contact from a list of contacts selected from the first user's contact database. This limitation is not met or otherwise suggested by Beaton.

Therefore combining Emerson with Beaton does not suggest the subject matter of the rejected claims, therefore, in view of the foregoing, the Applicants respectfully request reconsideration and withdrawal of the rejection

Claims 11-14 and 28-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Emerson, III (US 2003/0043974) in view of Toyryla et al. (US 2003/0083086).

In response, the Applicants submit the rejected claims are not obvious in view of the cited references as the teaching, motivation, or suggestion to make the claimed combination. As discussed in detail above, Emerson does not disclose transmitting, upon selection, the caller identification to at least one contact from a list of contacts selected from the first user's contact database. This limitation is not met or otherwise suggested by Toyryla. Indeed, the cited text merely states that groups "may be created and managed by sending standard messages, ie. in a way similar to distributing electronic business cards (and ringtones and logos)." (Page 3, para. 0042). Merely teaching that groups may be created by sending standard messages does not teach or otherwise suggest the subject matter of the rejected claims. Therefore, the Applicant's respectfully request reconsideration and withdrawal of the rejection.

Claim 35 is rejected under 35 U.S.C. §103(a) as being unpatentable over Emerson, III (US 2003/0043974) in view of Rosecrans et al. (U.S. Pat. No. 5,889,852).

In response, the Applicants submit the rejected claims are not obvious in view of the cited references as the teaching, motivation, or suggestion to make the claimed combination. The limitations of Emerson have been described above. These limitations are not met or otherwise satisfied by the teachings of Rosecrans. Rosecrans is directed towards telephones containing phonebooks and graphical user interfaces for displaying such phonebooks. As provided in the Summary of the Invention, "[t]he present invention is directed to a Graphical User Interface, for use with electronic phonebooks, that links graphical information, e.g. a graphic identifier such as

a logo or a picture, to a phone number that may be called using the graphic identifier when displayed on the interface. (Col. 1, lines 60 – 65; emphasis added). While one user may send/receive a photo or logo from another user, the photo or logo is not used for a Caller ID related function when a call is placed. Rather, the teachings of Rosecrans allow a user to choose a picture or logo (which may have been received from another user) representing a person or business to place a call rather than choosing the actual collection of digits comprising the phone number to call. In this regard, Rosecrans allows the calling party to review and possibly select the picture or logo and does not teach or otherwise suggest the subject matter of the rejected claim. Therefore, for at least these reasons, the Applicants respectfully request reconsideration and withdrawal of the rejection.

CONCLUSION

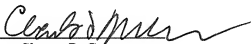
It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the number set forth below.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: December 8, 2005

By: 
Shawn P. Gorman
Reg. No. 56,197

BANNER & WITCOFF, LTD.
10 South Wacker Drive
Suite 3000
Chicago, IL 60606
Tel: (312) 463-5434
Fax: (312) 463-5001